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tesa 719-KGB

### REMARKS

Claims 12-30 are pending. Claims 12-13, 22-24 and 27 have been amended.

New claims 31 and 32 have been added.

No amendment adds new matter.

The claims have been objected to or rejected. The objections and rejections are addressed below.

Early and favorable consideration is requested.

### Objections to the Specification

Examiner asserts that no express support can be found in the specification for items (a) to (f) in section 2 of the office action. Each item is discussed below. Examiner is respectfully reminded that "it is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." MPEP § 2163. Thus, the original claims together with additional text in the specification provide ample support for the claim limitations that Examiner has indicated lack support.

(a) is supported on page 10, line 6.

(b) is supported on page 7, line 5.

(c) is supported by original claim 3, which is dependent on original claim 1. Claim 1 refers to the wt.-%s based on the weight of the aqueous dispersion. This relationship holds for dependent

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claim 15 and independent claim 12 as well. Support for the stabilizers being water-soluble can be found on page 7, 3rd paragraph.

(d) page 7, 3rd paragraph.

(e) is supported on page 5, 1st paragraph and original claim 4.

(f) original claim 4.

(g) original claim 5; page 5, line 1 – initiators soluble in organic media.

(h) original claim 6; page 8, 1st paragraph.

(i) original claim 7; page 8 paragraph 3 and 6 continuing to page 9.

(j) original claim 8; page 6, 3rd paragraph.

(k) original claim 9;

(l) original claim 10; page 3, last paragraph.

Withdrawal of these objections is respectfully requested.

#### Claim Objections

In response to the claim objections raised by Examiner, Applicants respond as follows:

Claim 13 has been amended in accordance with Examiner's suggestions.

However, the proposed amendments to claims 23-24 have been made previously, in the amendment filed April 8, 2004.

Withdrawal of the objections is respectfully requested.

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§ 112, 2nd Paragraph

In response to the rejections under this provision, the claims have been amended according to suggestions.

*In claim 12 and 13, the suggested changes were made. In claim 27, the term crosslinked was inserted prior to acrylic polymer, thereby distinguishing the term acrylic polymer from polyacrylate. The amendment clarifies that at different stages in the process the wt.-% of a component would be normalized differently due to the changing nature of the reaction products at the time that a particular step is performed. In this case, the first wt.-% normalization is to the polymerized dispersion, and the second is to the polymerized +/-crosslinked product.*

Anticipation and/or Obviousness Based on Dunaway

Newly amended claim 12 is not anticipated by Dunaway. There is no disclosure in Dunaway for *dewatering the concentrate aqueous dispersion under subatmospheric pressure during kneading and/or extrusion*. Accordingly, Dunaway does not explicitly or inherently anticipate the claimed process.

In addition, claim 12 is not rendered obvious by Dunaway because the reference does not explicitly or impliedly suggest the desirability of Dunaway's composition undergoing the steps of *dewatering the concentrate aqueous dispersion under subatmospheric pressure during kneading and/or extrusion*. At most, Dunaway teaches using the formulation of Example for an

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adhesive. The reference does not teach or suggest that the polymer dispersions should be kneaded and extruded at all, let alone under specific conditions. See column 14.

In addition, the specific limitation added to claim 12 is a step that contributes to the properties of the adhesive disclosed in the specification. For example, the claimed composition's bond strength and failure times are disclosed on pages 10, the penultimate paragraph, and page 11. The properties disclosed are not disclosed in Dunaway, and cannot reasonably be viewed as being inherently possessed by Dunaway's adhesive because there is no teaching of how it is actually compounded, if at all.

Examiner may believe that Dunaway's composition, even without disclosing any compounding steps, would inherently possess the properties demonstrated by the composition obtained by the claimed process. However, it is respectfully suggested that Examiner may not reasonably establish a *prima facie* case of inherency in the matter discussed above. As pointed out by the Board of Patent Appeals and Interferences in *Ex parte Levy*, 17 USPQ2d 1461, 1463-1464 (BPAI 1990):

"[T]he initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the Examiner. \* \* \* In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. [Emphasis in original.]"

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In view of the fact that the claimed process requires a specific manner of processing the composition, it cannot reasonably be concluded that Dunaway's composition renders the claimed process obvious.

Obviousness Over the Combination of Dunaway and LaRose

Claim 22 has been amended by adding a limitation that the process requires that at least one of the polyacrylate monomers is an acrylate or methacrylate ester and wherein the ester moiety has from 6 to 12 carbon atoms.

This limitation is supported by the specification on page 7, original claim 2 and the examples.

The process described in claim 22 is not taught or suggested by the combination of Dunaway and Rose. Neither reference describes a method of preparing a hot-melt pressure sensitive adhesive in which one of the steps requires at least one monomeric ester in which the ester groups are from C<sub>6</sub> to C<sub>12</sub>.

Further, Dunaway does not teach or suggest a particular extrusion and dewatering step. Apparently, Examiner believes that from a technological perspective, it may be a simple matter to process Dunaway's composition using a device and method such as LaRose's. However, Examiner is respectfully reminded that the combination of these references requires that Dunaway suggest this specific process step. "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of

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the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP, § 2143.01. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). (Emphasis added).

Applicants submit that Dunaway and LaRose do not suggest the claimed process.

In conclusion, it is believed that each of the objections and rejections have been effectively addressed and that the claims are in allowable condition.

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### CONDITIONAL PETITION FOR EXTENSION OF TIME


If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

### ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

Respectfully Submitted,

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